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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,646	11/18/1999	TOSHIHISA SARUTA	4947-0087-2	6214

22850 7590 04/07/2005

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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/442,646

**Applicant(s)**

SARUTA ET AL.

**Examiner**

Mark E. Wallerson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6-8, 16-18 and 23 is/are allowed.
- 6) ☐ Claim(s) 1-5, 9-15, 19-22 and 24 is/are rejected.
- 7) ☐ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/30/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 1/27/05.
2. This application has been reconsidered. Claims 1-25 are pending.

#### ***Response to Amendment***

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 3, 4, 5, 9, 10, 11, 12, 13, 14, 15, 19, 20, 21, 22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook (U.S. 6,565,181).

With respect to claims 1, 2, 9, 10, 11, 12, 14, 21, and 22, Silverbrook discloses a method of determining whether a storage unit included in an ink cartridge is normal (column 166, lines 7-31), wherein the ink cartridge is detachably attached to the printer, comprising reading a piece of ink related information (state data) that has been registered in advance in a predetermined format from the storage unit (column 166, lines 20-46); identifying whether the read-out information satisfies the predetermined format so as to determine whether the storage unit is normal or not normal if the information has been destroyed (altered) (column 167, lines 29-64; column 168, lines 1-13; column 174, lines 23-37; and column 207, lines 20-48). Silverbrook also discloses a display (15).

With regard to claims 4 and 13, Silverbrook discloses discontinuing a printing operation if the storage is not normal (column 147, line 60 to column 148, line 19).

With respect to claims 5, 15, and 24, Silverbrook discloses the state data includes the month of manufacture of the ink cartridge (column 257, lines 62-64).

With regard to claim 19, Silverbrook discloses a storage unit included in an ink cartridge (column 166, lines 8-65), wherein the ink cartridge is detachably attached to a printer (column 2, lines 57-65), the storage unit comprising: an address counter that outputs a count in response to a clock signal output from the printer (column 243, lines 55-67; and a storage element that stores plural pieces of specific information (state information) including a piece of ink related

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information registered in a predetermined format (column 166, lines 20-46) and that is sequentially accessed based on the count output from the address counter (column 249, lines 6-29 and column 257, lines 20-42).

With regard to claim 20, Silverbrook discloses an ink cartridge comprising a storage unit (column 4, lines 28-50 and column 147, line 60 to column 148, line 19).

### ***Allowable Subject Matter***

6. Claims 6-8, 16-18, and 23 are allowed.
7. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

8. Applicant's arguments filed 1/27/05 have been fully considered but they are not persuasive.

Applicant continues to submit that *Silverbrook* does not disclose determining whether a storage unit is not normal if a read-out piece of ink related information is destroyed. The Examiner again respectfully disagrees.

*Silverbrook* discloses reading consumable state information (which reads on ink related information) from the storage and determining whether this information has been tampered with (column 157, lines 30-48; column 158, lines 22-67; column 159, lines 46-62; column 199, lines

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17-23; column 205, lines 57-65; column 228, lines 39-54, and column 249, lines 1-28).

Applicant submits that “altered” is not synonymous with “destroyed”. Again, the Examiner disagrees. The Examiner believes that within the context of the instant application “altering” is the same as “destroying”, since the original state has been compromised. *Silverbrook* also discloses that if one of the keys of the consumable is compromised, the security mechanism for the consumable is made **void**, and the **damage** depends on the ease with which they can be reprogrammed (column 207, lines 20-48). Additionally, *Silverbrook* discloses detecting whether an attack has **permanently damaged** the chip (column 212, lines 17-30). This clearly reads on determining whether the read-out information has been “destroyed”.

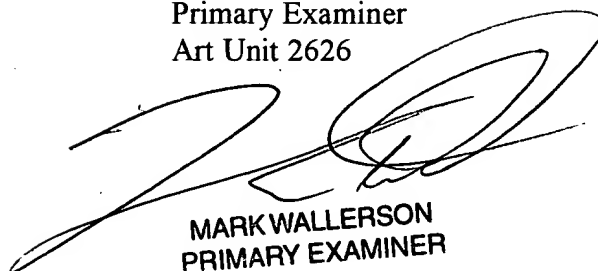
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER